



GREENBLUM & BERNSTEIN, P.L.C.
Intellectual Property Causes
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191

Mail Stop Appeal Brief-Patents
Confirmation No. 2402

In re application of : Andres SANCHEZ

Attorney Docket No. P18459

Serial No. : 09/407,174

Group Art Unit : 2642

Filed : September 28, 1999

Examiner : W. J. Deane, Jr.

For : METHOD FOR MANAGING INFORMATION IN A TELEPHONE AND TELEPHONE
FOR MANAGING INFORMATION

Mail Stop Appeal Brief-Patents

Commissioner for Patents

U.S. Patent and Trademark Office

Customer Service Window, Mail Stop Appeal Brief - Patents

Randolph Building

401 Dulany Street

Alexandria, VA 22314

Sir:

Transmitted herewith is an **Response To Notification Of Non-Compliant Appeal Brief And Supplemental Appeal Brief Under 37 C.F.R. § 41.37** in the above-captioned application.

☐ Small Entity Status of this application under 37 C.F.R. 1.9 and 1.27 has been established by a previously filed statement.

☐ A Request for Extension of Time.

☒ No additional fee is required.

The fee has been calculated as shown below:

| Claims After Amendment | No. Claims Previously Paid For | Present Extra | Small Entity | | Other Than A Small Entity | |
|-------------------------------------|--------------------------------|---------------|--------------|-----|---------------------------|---------|
| | | | Rate | Fee | Rate | Fee |
| Total Claims: 23 | *23 | 0 | X25= | \$ | x 50= | \$0.00 |
| Indep. Claims: 5 | **5 | 0 | X100= | \$ | X200= | \$ 0.00 |
| Multiple Dependent Claims Presented | | | +180= | \$ | +360= | \$ 0.00 |
| Extension Fees for ____ Month(s) | | | | \$ | | \$ 0.00 |
| Total: | | | | \$ | Total: | \$0.00 |

* If less than 20, write 20

** If less than 3, write 3

Please charge my Deposit Account No. 19-0089 in the amount of \$ ____.

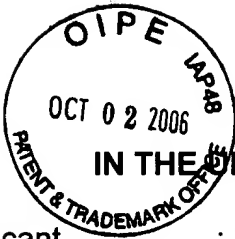
N/A A Check in the amount of \$ ____ to cover the filing/extension fee(s) is included.

☒ The U.S. Patent and Trademark Office is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 19-0089.

☒ Any additional filing fees required under 37 C.F.R. 1.16.

☒ Any patent application processing fees under 37 C.F.R. 1.17, including any required extension of time fees in any concurrent or future reply requiring a petition for extension of time for its timely submission (37 CFR 1.136)(a)(3).

Robert W. Mueller
Neil F. Greenblum
Reg. No. 35,043 Reg. No. 20,394



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Andres SANCHEZ Group Art Unit: No. 2642
Application No : 09/407,174 Examiner: W. J. Deane, Jr.
Filed : September 28, 1999 Confirmation No.: 2402
For: : METHOD FOR MANAGING INFORMATION IN A TELEPHONE
AND TELEPHONE FOR MANAGING INFORMATION

**RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF AND
SUPPLEMENTAL APPEAL BRIEF UNDER 37 C.F.R. § 41.37**

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Appeal Brief - Patents
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

In response to the Notification of Non-Compliant Appeal Brief of August 30, 2006, which set a response period of one month, Appellant submits herewith a Supplemental Appeal Brief Under 37 C.F.R. 41.37 that addresses the defects identified by the Examiner in Notification. Appellants submit this Supplemental Appeal Brief is submitted in support of Appellant's appeal from the Examiner's final rejection of claims 1, 2, and 4 – 24 as set forth in the Final Office Action of December 13, 2005.

A Notice of Appeal was filed June 12, 2006 with a three-month extension of time. Accordingly, the instant Appeal Brief is being timely submitted by the initial due date of August 14, 2006 (August 12, 2006 being a Saturday). Moreover, this Supplement Appeal Brief is being timely submitted within one month of mailing of the Notification of Non-Compliant Appeal Brief, i.e., by October 2, 2006 (September 30, 2006 being a Saturday).

The requisite fee under 37 C.F.R. 1.17(c) in the amount of \$ 500.00 for the filing of

the Appeal Brief was paid by check on August 14, 2006, such that no further fees are necessary for consideration of the instant appeal. However, if for any reason the necessary fee is not associated with this file, the undersigned authorizes the charging of any filing fees for the Appeal Brief and/or any necessary extension of time fees to Deposit Account No. 19 - 0089.

(1) REAL PARTY IN INTEREST

The real party in interest is Fenmore International, Ltd. Of Tortola, British Virgin Islands, by an assignment recorded in the U.S. Patent and Trademark Office on January 14, 2000 at Reel 010522 and Frame 0720.

(2) **RELATED APPEALS AND INTERFERENCES**

No related appeals and/or interferences are pending.

(3) STATUS OF THE CLAIMS

Claims 1, 2, and 4 – 24 stand finally rejected.

(4) STATUS OF THE AMENDMENTS

The Advisory Action of June 14, 2004 does not indicate whether Appellants' May 15, 2006 Amendment Under 37 C.F.R. 1.116 was for the purposes of this appeal. As the amendment merely changed the dependency of claim 6 from canceled claim 3 to pending claim 1, Appellants submit the Examiner's inadvertently failed to indicate entry of the amendment. Accordingly, the Listing of Claims includes claim 6 as amended May 15, 2006.

(5) SUMMARY OF CLAIMED SUBJECT MATTER

The instant invention is directed to an electronic telephone apparatus and a method for managing pieces of information (data) relating to telephone number lists stored in the telephone, in which the display and use of the data is allowed only after an access code is inputted into the telephone. (Page 1, lines 9 - 12).

The following descriptions are made with respect to the independent claim and include references to particular parts of the specification. As such, the following is merely exemplary and is not a surrender of other aspects of the present invention that are also enabled by the present specification and that are directed to equivalent structures or methods within the scope of the claims.

Independent claim 1 is directed to a method for managing telephone data used with a telephone. (Page 8, line 13; and Figure 2). The method includes storing telephone data related to at least one of incoming and outgoing telephone calls in at least one of a public call and private call list (Page 8, lines 18 – 21; and Figure 2), the public call list being accessible to any user during operation of the telephone. (Page 9, lines 14 – 17; and Figure 2). The method further includes limiting a user's access to the public telephone data in the public call list, until such time as the user of the telephone inputs a personal secret access code, after which, the user has access to the public telephone data in the public call list and to private telephone data in the private call list of private telephone data that is associated with the inputted personal secret access code. (Page 9, line 19 – 24; and Figure 3). Both the private call list and the public call list are stored in the telephone. (Page 9, lines 7 – 12; lines 14 – 17; and Figure 2).

Independent claim 11 is directed to a telephone that manages integrally stored

telephone data. The telephone includes a memory that stores telephone data related to at least one of incoming and outgoing telephone calls (Page 8, lines 3 and 4; lines 13 and 14; and Figures 1 and 2), a public list containing public telephone data is accessible to all users during operation of the telephone (Page 9, line 14 – 17; Figure 2), and a personal secret access code entry device that enables a user of the telephone to enter a personal secret access code. (Page 9, lines 7 – 12; Figure 2). Access to said stored telephone data is limited to said public list containing public telephone data, until such time as the user enters said personal secret access code, and after entering the personal secret access code, the user has access to said public telephone data contained in said public list and to a private list containing private telephone data that is associated with said inputted personal secret access code. (Page 9, lines 19 – 24; and Figure 3). Both the private telephone data and the public telephone data are stored in the telephone. (Page 9, lines 7 – 12; lines 14 – 17; and Figure 2).

Independent claim 16 is directed to a method for managing data used with a telephone. The method includes entering a personal secret access code into the telephone by a user of the telephone (Page 9, lines 19 – 24; and Figure 3), creating a private list containing telephone data associated with the personal secret access code entered by the user, the telephone data, composed of information related to incoming and outgoing telephone calls, collected and accessible only after entry of the associated personal secret access code (Page 11, lines 4 - 9; and Figure 3), and creating a public list accessible to all users during operation of the telephone which contains telephone data, composed of incoming and outgoing telephone calls, collected and accessible prior to entering the personal secret access code. (page 9, lines 14 – 17; and Figure 2). The

telephone numbers in both the private list and the public list are stored in the telephone. (Page 9, lines 7 – 12; lines 14 – 17; and Figure 2).

Independent claim 23 is directed to method for managing telephone data using a telephone that can be used by a plurality of users. The method includes storing in the telephone public telephone data related to at least one of incoming and outgoing telephone calls in a public list accessible to all users (Page 9, lines 14 – 17; and Figure 2), and storing in the telephone, for each of the plurality of users, private telephone data related to at least one of incoming and outgoing telephone calls in a respective private list (Page 9, lines 7 – 12; and Figure 2). Each respective private list is associated with a personal secret access code. (Page 9, lines 19 – 24; and Figure 3). The method also includes allowing each of the plurality of users access to the public type of telephone data (Page 9, lines 16 and 17; and Figure 2), preventing each of the plurality of users from accessing any of the private telephone data until a valid personal secret access code is entered (Page 9, lines 10 – 12; and Figure 2), allowing the user entering the valid personal secret access code to access the private telephone data associated with the valid personal secret access code (Page 9, lines 23 and 24; and Figure 3), and allowing another user entering another valid personal secret access code to access the private telephone data associated with another valid personal secret access code. (Page 16, lines 4 – 6; and Figure 5). Each personal secret access code is distinct. (Page 10, lines 14 and 15; and Figure 3).

(6) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

(A) Claims 1, 2, 4, 5, 11, 12, 16, 18, 23, and 24 are Rejected Under 35 U.S.C. § 103(a) as being Anticipated by IRVIN (U.S. Patent No. 6,195,568); and

(B) Claims 6 – 10, 13 – 15, 17, and 19 – 22 are Rejected Under 35 U.S.C. §103(a) as being Unpatentable over IRVIN in view of AUSTIN (U.S. Patent No. 6,259,908).

(7) **ARGUMENT**

(A) The Rejection of Claims 1, 2, 4, 5, 11, 12, 16, 18, 23, and 24 Under 35 U.S.C. § 103(a) As Anticipated by IRVIN is in Error, the Rejection Should be Reversed, and the Application Should be Remanded to the Examiner.

The Examiner asserts IRVIN essentially discloses all of the features recited in the noted claims, and refers to the Abstract, column 2, lines 3-67, and column 5, lines 1 – 8, 14 – 24 and 34 – 52, except for private telephone data, but asserts it would have been obvious to configure a user's profile to include a public phone book and a private phone book. Applicants traverse the Examiner's assertions.

Independent Claim 1:

Applicant's independent claim 1 recites, *inter alia*, storing telephone data related to at least one of incoming and outgoing telephone calls in at least one of a public call and private call list, *the public call list being accessible to any user during operation of the telephone, and limiting a user's access to the public telephone data in the public call list, until such time as the user of the telephone inputs a personal secret access code, after which, the user has access to the public telephone data in the public call list and to private telephone data in the private call list of private telephone data that is associated with the inputted personal secret access code.* Applicant submits that IRVIN fails to render unpatentable at least the above-noted features of the invention.

Applicant notes IRVIN discloses a communication device requiring a reference signature to be input to provide access to the phone and its features. Moreover, once access to the phone is provided, the user is given access to all features of the phone. In contrast, the present invention discloses a phone that is usable by any user without

entering a code. The user is granted access to the phone any telephone numbers stored in a public file. Once a user enters a private access number, the user, in addition to the access to stored public telephone numbers, is granted access to a private telephone directory associated with the private access number of the user.

Thus, Applicant submits that these features of the present invention, which are recited in at least the independent claims, are neither taught nor suggested by IRVIN. In particular, Applicants submit that, as IRVIN discloses a phone that is inoperable (or inaccessible) until a code or password is entered, this document fails to teach or suggest, *inter alia*, storing telephone data related to at least one of incoming and outgoing telephone calls in at least one of a public call and private call list, *the public call list being accessible to any user during operation of the telephone*, and *limiting a user's access to the public telephone data in the public call list, until such time as the user of the telephone inputs a personal secret access code*, after which, the user has access to the public telephone data in the public call list and to private telephone data in the private call list of private telephone data that is associated with the inputted personal secret access code, as recited in at least independent claim 1.

Moreover, while IRVIN discloses that once an identity is established, i.e., by inputting the reference signature or password, the telephone adapts its operational characteristics according to the stored settings associated with the user identity (see column 3, lines 35 - 40), Applicant notes there is no teaching or suggestion of private phone lists associated with different reference signatures that are accessible upon entry of the reference signature, and certainly no teaching or suggestion that the phone is operational and public features of the phone are accessible to any user without entry of a

reference signature.

Thus, contrary to the Examiner's assertions, Applicant submits there is no teaching or suggestion of stored public data being accessible by any or all users before entering a personal secret access code, or stored private data and stored public data being accessible to a user after entering a personal secret access code.

Because IRVIN fails to teach or suggestion at least the above-noted features of the instant invention, Applicant submits no proper modification of IRVIN can even arguable render unpatentable the combination of features recited in at least the independent claims.

Independent Claim 11:

Applicant's independent claim 11 recites, *inter alia*, *a public list containing public telephone data is accessible to all users during operation of the telephone*, and a personal secret access code entry device that enables a user of the telephone to enter a personal secret access code, in which *access to said stored telephone data is limited to said public list containing public telephone data, until such time as the user enters said personal secret access code*, and after entering the personal secret access code, the user has access to said public telephone data contained in said public list and to a private list containing private telephone data that is associated with said inputted personal secret access code. Applicant submits that IRVIN fails to render unpatentable at least the above-noted features of the invention.

Applicant notes IRVIN discloses a communication device requiring a reference signature to be input to provide access to the phone and its features. Moreover, once access to the phone is provided, the user is given access to all features of the phone. In contrast, the present invention discloses a phone that is usable by any user without

entering a code. The user is granted access to the phone any telephone numbers stored in a public file. Once a user enters a private access number, the user, in addition to the access to stored public telephone numbers, is granted access to a private telephone directory associated with the private access number of the user.

Thus, Applicant submits that these features of the present invention, which are recited in at least the independent claims, are neither taught nor suggested by IRVIN. In particular, Applicants submit that, as IRVIN discloses a phone that is inoperable (or inaccessible) until a code or password is entered, this document fails to teach or suggest, *inter alia*, a public list containing public telephone data is accessible to all users during operation of the telephone, and a personal secret access code entry device that enables a user of the telephone to enter a personal secret access code, in which *access to said stored telephone data is limited to said public list containing public telephone data, until such time as the user enters said personal secret access code*, and after entering the personal secret access code, the user has access to said public telephone data contained in said public list and to a private list containing private telephone data that is associated with said inputted personal secret access code, as recited in at least independent claim 11.

Moreover, while IRVIN discloses that once an identity is established, i.e., by inputting the reference signature or password, the telephone adapts its operational characteristics according to the stored settings associated with the user identity (see column 3, lines 35 - 40), Applicant notes there is no teaching or suggestion of private phone lists associated with different reference signatures that are accessible upon entry of the reference signature, and certainly no teaching or suggestion that the phone is operational and public features of the phone are accessible to any user without entry of a

reference signature.

Thus, contrary to the Examiner's assertions, Applicant submits there is no teaching or suggestion of stored public data being accessible by any or all users before entering a personal secret access code, or stored private data and stored public data being accessible to a user after entering a personal secret access code.

Because IRVIN fails to teach or suggestion at least the above-noted features of the instant invention, Applicant submits no proper modification of IRVIN can even arguable render unpatentable the combination of features recited in at least the independent claims.

Independent Claim 16:

Applicant's independent claim 16 recites, *inter alia*, creating a *private list containing telephone data associated with the personal secret access code entered by the user*, the telephone data, composed of information related to incoming and outgoing telephone calls, collected and accessible only after entry of the associated personal secret access code, and creating a *public list accessible to all users during operation of the telephone which contains telephone data*, composed of incoming and outgoing telephone calls, collected and accessible prior to entering the personal secret access code. Applicant submits that IRVIN fails to render unpatentable at least the above-noted features of the invention.

Applicant notes IRVIN discloses a communication device requiring a reference signature to be input to provide access to the phone and its features. Moreover, once access to the phone is provided, the user is given access to all features of the phone. In contrast, the present invention discloses a phone that is usable by any user without entering a code. The user is granted access to the phone any telephone numbers stored in a public file. Once a user enters a private access number, the user, in addition to the

access to stored public telephone numbers, is granted access to a private telephone directory associated with the private access number of the user.

Thus, Applicant submits that these features of the present invention, which are recited in at least the independent claims, are neither taught nor suggested by IRVIN. In particular, Applicants submit that, as IRVIN discloses a phone that is inoperable (or inaccessible) until a code or password is entered, this document fails to teach or suggest, *inter alia*, creating a private list containing telephone data associated with the personal secret access code entered by the user, the telephone data, composed of information related to incoming and outgoing telephone calls, *collected and accessible only after entry of the associated personal secret access code*, and creating a public list accessible to all users during operation of the telephone which contains telephone data, composed of incoming and outgoing telephone calls, *collected and accessible prior to entering the personal secret access code*, as recited in at least independent claim 16.

Moreover, while IRVIN discloses that once an identity is established, i.e., by inputting the reference signature or password, the telephone adapts its operational characteristics according to the stored settings associated with the user identity (see column 3, lines 35 - 40), Applicant notes there is no teaching or suggestion of private phone lists associated with different reference signatures that are accessible upon entry of the reference signature, and certainly no teaching or suggestion that the phone is operational and public features of the phone are accessible to any user without entry of a reference signature.

Thus, contrary to the Examiner's assertions, Applicant submits there is no teaching or suggestion of stored public data being accessible by any or all users before entering a

personal secret access code, or stored private data and stored public data being accessible to a user after entering a personal secret access code.

Because IRVIN fails to teach or suggestion at least the above-noted features of the instant invention, Applicant submits no proper modification of IRVIN can even arguable render unpatentable the combination of features recited in at least the independent claims.

Independent Claim 23:

Finally, Applicant's independent claim 23 recites, *inter alia*, storing in the telephone, *for each of the plurality of users, private telephone data related to at least one of incoming and outgoing telephone calls in a respective private list*, wherein each respective private list is associated with a personal secret access code, *allowing each of the plurality of users access to the public type of telephone data, preventing each of the plurality of users from accessing any of the private telephone data until a valid personal secret access code is entered*, and *allowing the user entering the valid personal secret access code to access the private telephone data associated with the valid personal secret access code*. Applicant submits that IRVIN fails to render unpatentable at least the above-noted features of the invention.

Applicant notes IRVIN discloses a communication device requiring a reference signature to be input to provide access to the phone and its features. Moreover, once access to the phone is provided, the user is given access to all features of the phone. In contrast, the present invention discloses a phone that is usable by any user without entering a code. The user is granted access to the phone any telephone numbers stored in a public file. Once a user enters a private access number, the user, in addition to the access to stored public telephone numbers, is granted access to a private telephone

directory associated with the private access number of the user.

Thus, Applicant submits that these features of the present invention, which are recited in at least the independent claims, are neither taught nor suggested by IRVIN. In particular, Applicants submit that, as IRVIN discloses a phone that is inoperable (or inaccessible) until a code or password is entered, this document fails to teach or suggest, *inter alia*, storing in the telephone, *for each of the plurality of users, private telephone data related to at least one of incoming and outgoing telephone calls in a respective private list*, wherein each respective private list is associated with a personal secret access code, *allowing each of the plurality of users access to the public type of telephone data, preventing each of the plurality of users from accessing any of the private telephone data until a valid personal secret access code is entered, and allowing the user entering the valid personal secret access code to access the private telephone data associated with the valid personal secret access code*, as recited in at least independent claim 23.

Moreover, while IRVIN discloses that once an identity is established, i.e., by inputting the reference signature or password, the telephone adapts its operational characteristics according to the stored settings associated with the user identity (see column 3, lines 35 - 40), Applicant notes there is no teaching or suggestion of private phone lists associated with different reference signatures that are accessible upon entry of the reference signature, and certainly no teaching or suggestion that the phone is operational and public features of the phone are accessible to any user without entry of a reference signature.

Thus, contrary to the Examiner's assertions, Applicant submits there is no teaching or suggestion of stored public data being accessible by any or all users before entering a

personal secret access code, or stored private data and stored public data being accessible to a user after entering a personal secret access code.

Because IRVIN fails to teach or suggestion at least the above-noted features of the instant invention, Applicant submits no proper modification of IRVIN can even arguable render unpatentable the combination of features recited in at least the independent claims.

Because the applied reference of IRVIN fails to teach or suggest at least the above-noted features of the independent claims, Appellant submits that IRVIN fails to render unpatentable the Appellant's invention under 35 U.S.C. §103(a). Accordingly, the Board is respectfully requested to reverse the Examiner's decision to finally reject independent claims 1, 11, 16, and 23 under 35 U.S.C. § 103(a).

Dependent Claims:

For these reasons, Applicant respectfully submits that independent claims 1, 11, 16 and 23 are allowable over IRVIN or any proper combination of the prior art of record. Moreover, Applicant submits that claims 2 – 5, 12, 18, and 24 are also allowable over IRVIN at least for the reason that these claims depend from allowable base claims and because these claims recite additional features that further define the invention over the art or record. Thus, Applicant submits IRVIN fails to anticipate the invention recited in at least claims 2 – 5, 12, 18, and 24.

Claim 2:

Appellant submits that claim 2 is allowable at least for the reason that it depends from allowable base claims and because it recites additional features that further define the present invention. In particular, Appellant submits that disclosure and figures of IRVIN fail to positively disclose displaying on a display associated with the telephone at least one of

the public call list of public telephone data and the private call list of private telephone data, as recited in claim 2.

Accordingly, Appellant submits that the Examiner has failed to provide an adequate evidentiary basis to support a rejection of anticipation under 35 U.S.C. § 103(a). Thus, Appellant submits that the rejection of independent claim 2 is improper and should be withdrawn.

Claim 4:

Appellant submits that claim 4 is allowable at least for the reason that it depends from allowable base claims and because it recites additional features that further define the present invention. In particular, Appellant submits that disclosure and figures of IRVIN fail to positively disclose inputting of a personal secret access code comprises manipulating a predetermined key sequence on a keypad of the telephone to initiate an operation to enter the personal secret access code, as recited in claim 4.

Accordingly, Appellant submits that the Examiner has failed to provide an adequate evidentiary basis to support a rejection of anticipation under 35 U.S.C. § 103(a). Thus, Appellant submits that the rejection of independent claim 4 is improper and should be withdrawn.

Claim 5:

Appellant submits that claim 5 is allowable at least for the reason that it depends from allowable base claims and because it recites additional features that further define the present invention. In particular, Appellant submits that disclosure and figures of IRVIN fail to positively disclose the storing of telephone data comprises storing the public telephone data and the private telephone data in the respective public call and private call lists of

public telephone data and private telephone data on a common list, the private telephone data being hidden from the user until the user inputs the personal secret access code, as recited in claim 5.

Moreover, the Examiner has also asserted that the features of claim 5 were inherent in IRVIN. However, the Examiner is reminded that in order for inherency to be present the Examiner has the burden of showing that the result indicated by the Examiner is the necessary result, and not merely a possible result. In re Oelrich, 212 U.S.P.Q. 323 (CCPA 1981); *Ex parte Keith et al.*, 154 U.S.P.Q. 320 (POBA 1966). The fact that a prior art article *may* inherently have the characteristics of the claimed product is not sufficient. *Ex parte Skinner*, 2 U.S.P.Q.2d 1788 (BPAI 1986).

As the Board of Patent Appeals and Interferences states in Ex parte Levy, 17 U.S.P.Q.2d 1461, 1463:

However, the initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention rests upon the examiner. *In re Piasecki*, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984). In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art. *In re King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986); *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983); *In re Oelrich*, 666 F.2d 578, 212 USPQ 323 (CCPA 1981); *In re Wilding*, 535 F.2d 631, 190 USPQ 59 (CCPA 1976); *Hansgirk v. Kemmer*, 102 F.2d 212, 40 USPQ 665 (CCPA 1939). in order for inherency to be present it must be a necessary result, and not merely a possible results. *Ex parte Keith and Turnquest*, 154 U.S.P.Q. 320 (B.O.A. 1966).

In the instant situation, the Examiner has not provided any explanation, and therefore has not provided any reasoning to support that the features of Appellant's claim 5 are the necessary result of the disclosure of IRVIN.

Accordingly, Appellant submits that the Examiner has failed to provide an adequate

evidentiary basis to support a rejection of anticipation under 35 U.S.C. § 103(a). Thus, Appellant submits that the rejection of independent claim 5 is improper and should be withdrawn.

Claim 12:

Appellant submits that claim 12 is allowable at least for the reason that it depends from allowable base claims and because it recites additional features that further define the present invention. In particular, Appellant submits that disclosure and figures of IRVIN fail to positively disclose a display that provides a visual indication of at least one of said public telephone data contained in said public list and said private telephone data contained in said private list, as recited in claim 12.

Accordingly, Appellant submits that the Examiner has failed to provide an adequate evidentiary basis to support a rejection of anticipation under 35 U.S.C. § 103(a). Thus, Appellant submits that the rejection of independent claim 12 is improper and should be withdrawn.

Claim 18:

Appellant submits that claim 18 is allowable at least for the reason that it depends from allowable base claims and because it recites additional features that further define the present invention. In particular, Appellant submits that disclosure and figures of IRVIN fail to positively disclose storing a plurality of personal secret access codes, the telephone numbers in the private list being associated with various personal secret access codes, a current personal secret access code entered into the telephone by a current user being limited to accessing telephone numbers in the private list that are associated with the current personal secret access code entered by the current user, as recited in claim 18.

Accordingly, Appellant submits that the Examiner has failed to provide an adequate evidentiary basis to support a rejection of anticipation under 35 U.S.C. § 103(a). Thus, Appellant submits that the rejection of independent claim 18 is improper and should be withdrawn.

Claim 24:

Appellant submits that claim 24 is allowable at least for the reason that it depends from allowable base claims and because it recites additional features that further define the present invention. In particular, Appellant submits that disclosure and figures of IRVIN fail to positively disclose the telephone includes a display, a keypad and a storage device which stores both the public type and the private type of telephone data, as recited in claim 24.

Accordingly, Appellant submits that the Examiner has failed to provide an adequate evidentiary basis to support a rejection of anticipation under 35 U.S.C. § 103(a). Thus, Appellant submits that the rejection of independent claim 24 is improper and should be withdrawn.

Therefore, Appellant respectfully requests that the decision of the Examiner to finally reject claims 1 – 5, 11, 12, 16, 18, 23, and 24 under 35 U.S.C. § 103(a) be reversed, and that the application be remanded to the Examiner for withdrawal of the rejection over IRVIN and an early allowance of all claims on appeal.

(B) The Rejection of Claims 6 – 10, 13 – 15, 17, and 19 – 22 Under 35 U.S.C §103(a) as being Unpatentable over IRVIN in View of AUSTIN is in Error, the Rejection Should be Reversed, and the Application Should be Remanded to the Examiner.

The Examiner asserts that IRVIN shows all the features of the claimed invention except for the first and second modes, and it would have been obvious to one of ordinary skill in the art to modify IRVIN to include a security feature described by AUSTIN. Applicant traverses the Examiner's assertions.

A § 103 rejection requires the Examiner to first establish a prima facie case of obviousness: "The Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the Examiner does not produce a prima facie case, the Appellants are under no obligation to submit evidence of nonobviousness." MPEP 2142. The Court of Appeals for the Federal Circuit has set forth three elements, which must be shown for prima facie obviousness:

"First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teachings or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

Applicant notes that AUSTIN fails to teach or suggest any of the subject matter noted above as deficient in IRVIN. In particular, Applicant submits that AUSTIN, like IRVIN, fails to teach or suggest a phone usable by any user without entering a code, in which the user is granted access to the phone any telephone numbers stored in a public file, and once a user enters a private access number, the user, in addition to the access to stored public telephone numbers, is granted access to a private telephone directory associated with the private access number of the user, as recited in the independent claims.

Thus, Applicant submits that neither IRVIN nor AUSTIN teach or suggest a phone that is inoperable (or inaccessible) until a code or password is entered, this document fails to teach or suggest, *inter alia*, storing telephone data related to at least one of incoming and outgoing telephone calls in at least one of a public call and private call list, *the public call list being accessible to any user during operation of the telephone*, and *limiting a user's access to the public telephone data in the public call list, until such time as the user of the telephone inputs a personal secret access code*, after which, the user has access to the public telephone data in the public call list and to private telephone data in the private call list of private telephone data that is associated with the inputted personal secret access code, as recited in at least independent claim 1, or, *inter alia*, *a public list containing public telephone data is accessible to all users during operation of the telephone*, and a personal secret access code entry device that enables a user of the telephone to enter a personal secret access code, in which *access to said stored telephone data is limited to said public list containing public telephone data, until such time as the user enters said personal secret access code*, and after entering the personal secret access code, the user has access to said public telephone data contained in said public list and to a private list containing private telephone data that is associated with said inputted personal secret access code, as recited in at least independent claim 16, or, *inter alia*, *creating a private list containing telephone data associated with the personal secret access code entered by the user*, the telephone data, composed of information related to incoming and outgoing telephone calls, *collected and accessible only after entry of the associated personal secret access code*, and *creating a public list accessible to all users during operation of the telephone which contains telephone data*, composed of incoming and outgoing telephone calls, *collected*

and accessible prior to entering the personal secret access code, as recited in at least independent claim 16; or, inter alia, storing in the telephone, for each of the plurality of users, private telephone data related to at least one of incoming and outgoing telephone calls in a respective private list, wherein each respective private list is associated with a personal secret access code, allowing each of the plurality of users access to the public type of telephone data, preventing each of the plurality of users from accessing any of the private telephone data until a valid personal secret access code is entered, and allowing the user entering the valid personal secret access code to access the private telephone data associated with the valid personal secret access code, as recited in at least independent claim 23.

Because neither applied document teaches or suggests at least the above-noted features of Applicant's invention, Applicant submits that no proper combination of these documents can even arguably render unpatentable the invention recited in at least the independent.

For these reasons, Applicant respectfully submits that independent claims 1, 11, 16 and 23 are allowable over any proper combination of IRVIN in view of AUSTIN. Moreover, Applicant submits that dependent claims 6 – 10, 13 – 15, 17, and 19 – 22 are also allowable over any proper combination of IRVIN in view of AUSTIN at least for the reason that these claims depend from allowable base claims and because these claims recite additional features that further define the invention over the art or record. Thus, Applicant submits IRVIN fails to anticipate the invention recited in at least claims 6 – 10, 13 – 15, 17, and 19 – 22.

Claim 6:

Appellant submits that claim 6 is allowable at least for the reason that it depends from allowable base claims and because it recites additional features that further define the present invention. In particular, Appellant submits that disclosure and figures of IRVIN fail to positively disclose providing two operating modes of the telephone, a first mode that has no access restrictions, and a second mode with access restrictions, as recited in claim 6.

Accordingly, Appellant submits that the Examiner has failed to provide an adequate evidentiary basis to support a rejection of anticipation under 35 U.S.C. § 103(a). Thus, Appellant submits that the rejection of independent claim 6 is improper and should be withdrawn.

Claim 7:

Appellant submits that claim 7 is allowable at least for the reason that it depends from allowable base claims and because it recites additional features that further define the present invention. In particular, Appellant submits that disclosure and figures of IRVIN fail to positively disclose rejecting an incoming call, and blocking of any indication of the incoming call, when a telephone number is designated as a protected telephone number, as recited in claim 7.

Accordingly, Appellant submits that the Examiner has failed to provide an adequate evidentiary basis to support a rejection of anticipation under 35 U.S.C. § 103(a). Thus, Appellant submits that the rejection of independent claim 7 is improper and should be withdrawn.

Claim 8:

Appellant submits that claim 8 is allowable at least for the reason that it depends from allowable base claims and because it recites additional features that further define the

present invention. In particular, Appellant submits that disclosure and figures of IRVIN fail to positively disclose switching between the two operating modes by manipulating a predetermined keyboard command, as recited in claim 8.

Accordingly, Appellant submits that the Examiner has failed to provide an adequate evidentiary basis to support a rejection of anticipation under 35 U.S.C. § 103(a). Thus, Appellant submits that the rejection of independent claim 8 is improper and should be withdrawn.

Claim 9:

Appellant submits that claim 9 is allowable at least for the reason that it depends from allowable base claims and because it recites additional features that further define the present invention. In particular, Appellant submits that disclosure and figures of IRVIN fail to positively disclose the predetermined keyboard command comprises manipulating one of a particular sequence of commands and a plurality of contemporary commands, as recited in claim 9.

Accordingly, Appellant submits that the Examiner has failed to provide an adequate evidentiary basis to support a rejection of anticipation under 35 U.S.C. § 103(a). Thus, Appellant submits that the rejection of independent claim 9 is improper and should be withdrawn.

Claim 10:

Appellant submits that claim 10 is allowable at least for the reason that it depends from allowable base claims and because it recites additional features that further define the present invention. In particular, Appellant submits that disclosure and figures of IRVIN fail to positively disclose delaying the switching between the two operating modes until the

user inputs the personal secret access code, as recited in claim 10.

Accordingly, Appellant submits that the Examiner has failed to provide an adequate evidentiary basis to support a rejection of anticipation under 35 U.S.C. § 103(a). Thus, Appellant submits that the rejection of independent claim 10 is improper and should be withdrawn.

Claim 13:

Appellant submits that claim 13 is allowable at least for the reason that it depends from allowable base claims and because it recites additional features that further define the present invention. In particular, Appellant submits that disclosure and figures of IRVIN fail to positively disclose an inhibitor that prevents at least one of a visual indication and an audible indication of an incoming call when a telephone number of said incoming call is designated to be a private call corresponding to a personal secret access code that has not been inputted into said telephone by a current user of said telephone, as recited in claim 13.

Accordingly, Appellant submits that the Examiner has failed to provide an adequate evidentiary basis to support a rejection of anticipation under 35 U.S.C. § 103(a). Thus, Appellant submits that the rejection of independent claim 13 is improper and should be withdrawn.

Claim 14:

Appellant submits that claim 14 is allowable at least for the reason that it depends from allowable base claims and because it recites additional features that further define the present invention. In particular, Appellant submits that disclosure and figures of IRVIN fail to positively disclose said personal secret access code is inputted by manipulating a

predetermined key sequence on a keypad of said telephone to initiate an operation to enter said personal secret access code, as recited in claim 14.

Accordingly, Appellant submits that the Examiner has failed to provide an adequate evidentiary basis to support a rejection of anticipation under 35 U.S.C. § 103(a). Thus, Appellant submits that the rejection of independent claim 14 is improper and should be withdrawn.

Claim 15:

Appellant submits that claim 15 is allowable at least for the reason that it depends from allowable base claims and because it recites additional features that further define the present invention. In particular, Appellant submits that disclosure and figures of IRVIN fail to positively disclose said personal secret access code is inputted by manipulating a predetermined sequence of simultaneous commands for a predetermined time period on a keypad of said telephone to initiate an operation to enter said personal secret access code, as recited in claim 15.

Accordingly, Appellant submits that the Examiner has failed to provide an adequate evidentiary basis to support a rejection of anticipation under 35 U.S.C. § 103(a). Thus, Appellant submits that the rejection of independent claim 15 is improper and should be withdrawn.

Claim 17:

Appellant submits that claim 17 is allowable at least for the reason that it depends from allowable base claims and because it recites additional features that further define the present invention. In particular, Appellant submits that disclosure and figures of IRVIN fail to positively disclose preventing the user from being notified of an incoming call when the

telephone number of the incoming call is designated as a private telephone number and the user that designated the incoming call as a private telephone number is not a current user of the telephone, as recited in claim 17.

Accordingly, Appellant submits that the Examiner has failed to provide an adequate evidentiary basis to support a rejection of anticipation under 35 U.S.C. § 103(a). Thus, Appellant submits that the rejection of independent claim 17 is improper and should be withdrawn.

Claim 19:

Appellant submits that claim 19 is allowable at least for the reason that it depends from allowable base claims and because it recites additional features that further define the present invention. In particular, Appellant submits that disclosure and figures of IRVIN fail to positively disclose preventing the current user from being notified of an incoming call when the incoming call is designated as a private telephone number associated with a personal secret access code that differs from that of the current user, as recited in claim 19.

Accordingly, Appellant submits that the Examiner has failed to provide an adequate evidentiary basis to support a rejection of anticipation under 35 U.S.C. § 103(a). Thus, Appellant submits that the rejection of independent claim 19 is improper and should be withdrawn.

Claim 20:

Appellant submits that claim 20 is allowable at least for the reason that it depends from allowable base claims and because it recites additional features that further define the present invention. In particular, Appellant submits that disclosure and figures of IRVIN fail

to positively disclose switching between a public operating mode and a private operating mode by manipulating a predetermined command on a keyboard of the telephone, as recited in claim 20.

Accordingly, Appellant submits that the Examiner has failed to provide an adequate evidentiary basis to support a rejection of anticipation under 35 U.S.C. § 103(a). Thus, Appellant submits that the rejection of independent claim 20 is improper and should be withdrawn.

Claim 21:

Appellant submits that claim 21 is allowable at least for the reason that it depends from allowable base claims and because it recites additional features that further define the present invention. In particular, Appellant submits that disclosure and figures of IRVIN fail to positively disclose entering the personal secret access code comprises manipulating a predetermined key on a keypad of the telephone for a predetermined period of time to initiate an operation to enter the personal secret access code, as recited in claim 21.

Accordingly, Appellant submits that the Examiner has failed to provide an adequate evidentiary basis to support a rejection of anticipation under 35 U.S.C. § 103(a). Thus, Appellant submits that the rejection of independent claim 21 is improper and should be withdrawn.

Claim 22:

Appellant submits that claim 22 is allowable at least for the reason that it depends from allowable base claims and because it recites additional features that further define the present invention. In particular, Appellant submits that disclosure and figures of IRVIN fail to positively disclose entering the personal secret access code comprises manipulating a

predetermined sequence of simultaneous commands on a keypad of the telephone for a predetermined period of time to initiate an operation to enter the personal secret access code, as recited in claim 22.

Accordingly, Appellant submits that the Examiner has failed to provide an adequate evidentiary basis to support a rejection of anticipation under 35 U.S.C. § 103(a). Thus, Appellant submits that the rejection of independent claim 22 is improper and should be withdrawn.

Therefore, Appellant respectfully requests that the decision of the Examiner to finally reject claims 6 – 10, 13 – 15, 17, and 19 – 22 under 35 U.S.C. § 103(a) be reversed, and that the application be remanded to the Examiner for withdrawal of the rejection over any proper combination of IRVIN in view of AUSTIN and an early allowance of all claims on appeal.

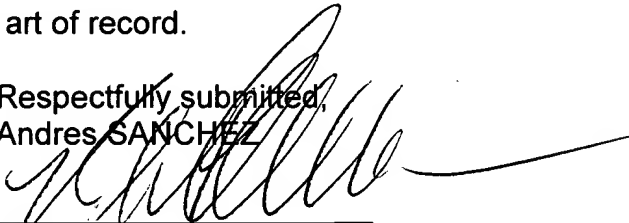
(C) Conclusion

Claims 1 – 5, 11, 12, 16, 18, 23, and 24 are patentable under 35 U.S.C. § 103(a) over IRVIN; and Claims 6 – 10, 13 – 15, 17, and 19 - 22 are patentable under 35 U.S.C. § 103(a) over IRVIN in view of AUSTIN. Specifically, the applied art of record fails to anticipate or render unpatentable the unique combination of features recited in Appellant's claims 1, 2, 4 - 24. Accordingly, Appellant respectfully requests that the Board reverse the Examiner's decision to finally reject claims 1 – 5, 11, 12, 16, 18, 23, and 24 under 35 U.S.C. § 103(a), and claims 6 – 10, 13 – 15, 17, and 19 - 22 under 35 U.S.C. § 103(a) and remand the application to the Examiner for withdrawal of the rejection.

Thus, Appellant respectfully submits that each and every pending claim of the present application meets the requirements for patentability under 35 U.S.C. §112, second

paragraph, 35 U.S.C. §102(b), and 35 U.S.C. §103(a), and that the present application and each pending claim are allowable over the prior art of record.

Respectfully submitted,
Andres SANCHEZ



Neil F. Greenblum
Reg. No. 28,394

Robert W. Mueller
Reg. No. 35,013

October 2, 2006
GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191

Attachments: Claims Appendix
Evidence Appendix
Related Proceedings Appendix

8) CLAIMS APPENDIX

The following listing of claims is a listing of all pending claims in the instant application:

Listing of Claims

1. (Previously presented) A method for managing telephone data used with a telephone, comprising:

storing telephone data related to at least one of incoming and outgoing telephone calls in at least one of a public call and private call list, the public call list being accessible to any user during operation of the telephone; and

limiting a user's access to the public telephone data in the public call list, until such time as the user of the telephone inputs a personal secret access code, after which, the user has access to the public telephone data in the public call list and to private telephone data in the private call list of private telephone data that is associated with the inputted personal secret access code,

wherein both the private call list and the public call list are stored in the telephone.

2. (Previously presented) The method of claim 1, further comprising:

displaying on a display associated with the telephone at least one of the public call list of public telephone data and the private call list of private telephone data.

3. (Canceled)

4. (Original) The method of claim 1, wherein inputting of a personal secret access

code comprises:

manipulating a predetermined key sequence on a keypad of the telephone to initiate an operation to enter the personal secret access code.

5. (Previously presented) The method of claim 1, wherein the storing of telephone data comprises:

storing the public telephone data and the private telephone data in the respective public call and private call lists of public telephone data and private telephone data on a common list, the private telephone data being hidden from the user until the user inputs the personal secret access code.

6. (Previously Presented) The method of claim 1, further comprising:

providing two operating modes of the telephone, a first mode that has no access restrictions, and a second mode with access restrictions.

7. (Previously Presented) The method of claim 6, further comprising:

rejecting an incoming call, and blocking of any indication of the incoming call, when a telephone number is designated as a protected telephone number.

8. (Original) The method of claim 6, further comprising:

switching between the two operating modes by manipulating a predetermined keyboard command.

9. (Original) The method of claim 8, wherein the predetermined keyboard command comprises:

manipulating one of a particular sequence of commands and a plurality of contemporary commands.

10. (Original) The method of claim 8, further comprising:

delaying the switching between the two operating modes until the user inputs the personal secret access code.

11. (Previously presented) A telephone that manages integrally stored telephone data, comprising:

a memory that stores telephone data related to at least one of incoming and outgoing telephone calls; and

a public list containing public telephone data is accessible to all users during operation of the telephone;

a personal secret access code entry device that enables a user of the telephone to enter a personal secret access code,

wherein access to said stored telephone data is limited to said public list containing public telephone data, until such time as the user enters said personal secret access code, and after entering the personal secret access code, the user has access to said public telephone data contained in said public list and to a private list containing private telephone data that is associated with said inputted personal secret access code,

wherein both the private telephone data and the public telephone data are stored in

the telephone.

12. (Original) The telephone of claim 11, further comprising:

a display that provides a visual indication of at least one of said public telephone data contained in said public list and said private telephone data contained in said private list.

13. (Original) The telephone of claim 11, further comprising:

an inhibitor that prevents at least one of a visual indication and an audible indication of an incoming call when a telephone number of said incoming call is designated to be a private call corresponding to a personal secret access code that has not been inputted into said telephone by a current user of said telephone.

14. (Original) The telephone of claim 13, wherein said personal secret access code is inputted by manipulating a predetermined key sequence on a keypad of said telephone to initiate an operation to enter said personal secret access code.

15. (Original) The telephone of claim 13, wherein said personal secret access code is inputted by manipulating a predetermined sequence of simultaneous commands for a predetermined time period on a keypad of said telephone to initiate an operation to enter said personal secret access code.

16. (Previously presented) A method for managing data used with a telephone,

comprising:

entering a personal secret access code into the telephone by a user of the telephone;

creating a private list containing telephone data associated with the personal secret access code entered by the user, the telephone data, composed of information related to incoming and outgoing telephone calls, collected and accessible only after entry of the associated personal secret access code; and

creating a public list accessible to all users during operation of the telephone which contains telephone data, composed of incoming and outgoing telephone calls, collected and accessible prior to entering the personal secret access code,

wherein the telephone numbers in both the private list and the public list are stored in the telephone.

17. (Original) The method of claim 16, further comprising:

preventing the user from being notified of an incoming call when the telephone number of the incoming call is designated as a private telephone number and the user that designated the incoming call as a private telephone number is not a current user of the telephone.

18. (Original) The method of claim 16, further comprising:

storing a plurality of personal secret access codes, the telephone numbers in the private list being associated with various personal secret access codes, a current personal secret access code entered into the telephone by a current user being limited to accessing

telephone numbers in the private list that are associated with the current personal secret access code entered by the current user.

19. (Previously Presented) The method of claim 18, further comprising:

preventing the current user from being notified of an incoming call when the incoming call is designated as a private telephone number associated with a personal secret access code that differs from that of the current user.

20. (Original) The method of claim 16, further comprising:

switching between a public operating mode and a private operating mode by manipulating a predetermined command on a keyboard of the telephone.

21. (Original) The method of claim 16, wherein entering the personal secret access code comprises:

manipulating a predetermined key on a keypad of the telephone for a predetermined period of time to initiate an operation to enter the personal secret access code.

22. (Original) The method of claim 16, wherein entering the personal secret access code comprises:

manipulating a predetermined sequence of simultaneous commands on a keypad of the telephone for a predetermined period of time to initiate an operation to enter the personal secret access code.

23. (Previously presented) A method for managing telephone data using a telephone that can be used by a plurality of users, the method comprising:

storing in the telephone public telephone data related to at least one of incoming and outgoing telephone calls in a public list accessible to all users;

storing in the telephone, for each of the plurality of users, private telephone data related to at least one of incoming and outgoing telephone calls in a respective private list, wherein each respective private list is associated with a personal secret access code;

allowing each of the plurality of users access to the public type of telephone data;

preventing each of the plurality of users from accessing any of the private telephone data until a valid personal secret access code is entered;

allowing the user entering the valid personal secret access code to access the private telephone data associated with the valid personal secret access code; and

allowing another user entering another valid personal secret access code to access the private telephone data associated with another valid personal secret access code,

wherein each personal secret access code is distinct.

24. (Previously Presented) A telephone which can be used to practice the method of claim 23, wherein the telephone includes a display, a keypad and a storage device which stores both the public type and the private type of telephone data.

(9) **EVIDENCE APPENDIX**

None.

(10) **RELATED PROCEEDINGS APPENDIX**

None.